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IN THE UNITED STATES DISTRICT COURT
FOR THE CENTRAL DISTRICT OF CALIFORNIA, WESTERN DIVISION

CARL ZEISS AG and ASML
NETHERLANDS B.V.,

Plaintiffs,

v.

NIKON CORPORATION, SENDAI
NIKON CORPORATION, and NIKON
INC.,

Defendants.

Case No. 2:17-cv-03221-RGK (MRWx)

**PLAINTIFFS' REPLY IN SUPPORT
OF MOTION TO REQUIRE
DISCLOSURE OF CLAIMS NIKON
PLANS TO RAISE AT TRIAL**

Hearing Date: July 23, 2018, 9:00 a.m.

Courtroom: 850

Judge: Hon. R. Gary Klausner

PLAINTIFFS' REPLY IN SUPPORT OF MOTION TO REQUIRE DISCLOSURE
OF CLAIMS NIKON PLANS TO RAISE AT TRIAL
Case No. 2:17-cv-03221-RGK (MRWx)

1 Plaintiffs Carl Zeiss AG and ASML Netherlands B.V. (“Plaintiffs”) offer this
2 short reply in support of their Motion to Require Disclosure of Claims Nikon Plans to
3 Raise at Trial (Doc. No. 430).

4 Plaintiffs’ motion was simple and straightforward. Local Rule 16-2.8
5 specifically requires that “[e]ach party shall disclose to every other party which of the
6 party’s pleaded claims and defenses the party plans to pursue, together with the party’s
7 contentions regarding the applicable facts and law.” Local Rule 16-2.8. In their
8 motion, Plaintiffs merely asked that this Court order Nikon to comply with this rule
9 and (1) disclose which prior art references Nikon plans to raise at trial, and (2) disclose
10 the basis for Nikon’s purported ownership defense. As explained in the motion, Nikon
11 does not contend that it plans to raise all fifteen prior art references at trial, yet Nikon
12 refuses to disclose which of those references it will use. Nikon additionally refuses
13 to provide any legally-sound basis for challenging Plaintiff’s ownership of the
14 asserted patents. Plaintiffs must have a fair opportunity to prepare for trial, and must
15 be allowed to know what claims Nikon actually plans to raise at trial and the basis for
16 those claims.

17 Nikon’s response is directed to casting Plaintiffs’ in a bad light. For example,
18 Nikon contends that Plaintiffs’ motion is “vexatious” simply because this Court
19 decided not to hear the motion on a non-expedited basis. Nikon also provides its oft-
20 repeated characterization of Plaintiffs’ acquisition of the patents-in-suit—***all without***
21 ***citing a single case*** suggesting that anything about how Plaintiffs’ acquired the patents
22 was improperly or legally ineffective to transfer title. If anything, these arguments
23 demonstrate ***why*** Plaintiffs brought their motion—it is clear from Nikon’s filing that
24 Nikon plans to force Plaintiffs to waste time walking through their acquisition of the
25 patents-in-suit where there is no dispute as to ownership, while at the same time trying
26 to use this ownership challenge as a back-door to circumvent this Court’s grant of
27

1 Plaintiffs’ motion in limine to exclude prejudicial evidence concerning Plaintiffs’
2 acquisition of the patents. (*See* D.I. 274; DI. 430-3, at 4:22-5:1.)

3 Nikon appears to make only one legal argument that is relevant to the basis for
4 Plaintiffs’ motion—arguing that “the purpose of [Rule 16-2.8] is to prevent the use of
5 claims or defenses not disclosed.” Resp. at 3. Nikon is only half right. Plainly, all of
6 Rule 16.2 is designed to allow the parties to prepare for trial and to winnow down the
7 issues that must be presented to a jury. For example (and as relevant here), Rule 16-
8 2.2 encourages parties to “make every effort to stipulate to facts upon which the parties
9 know or have reason to know there can be no dispute.” Rule 16.2 also requires
10 disclosure of exhibits, witnesses, etc. And, as pointed out, Rule 16-2.8 requires parties
11 to disclose *which* of the pleaded contentions the parties actually plan to bring to trial.
12 As this Court has recognized, the very point of the rule is a recognition that cases are
13 narrowed for trial, and that every claim or defense plead or disclosed in the discovery
14 process will not end up making it to trial. *See Lisker v. City of Los Angeles*, No. CV
15 09-09374 AHM AJWX, 2011 WL 3420665, at *2 (C.D. Cal. Aug. 4, 2011)
16 (recognizing that Rule 16-2.8 is designed to winnow claims plead down for trial).
17 General, conclusory allegations—such as identifying a broad swath of 15 potential
18 prior art references or vague “hot potato” ownership challenges—are not sufficient.
19 *See Matrix Int’l Textile, Inc. v. Monopoly Textile, Inc.*, No. CV160084FMOAJWX,
20 2017 WL 2929379, at *2 (C.D. Cal. May 12, 2017) (rejecting a general and
21 “conclusory” disclosure under Rule 16-2.8).

22 As to disclosure of prior art references, Nikon does not dispute that it does not
23 plan to bring fifteen prior art references to trial. Indeed, Nikon explicitly states that it
24 is “working to narrow down its own case further.” Resp., at 3. All Plaintiffs’ motion
25 asks is that Plaintiffs be kept in the loop so that they have a fair opportunity to prepare
26 for trial. As to the ownership challenge, Nikon continues to fail to provide any legally-
27 viable claim that Plaintiffs’ do not own the patents, nor does Nikon even assert in its

1 motion that Nikon disputes that Plaintiffs own them. Instead, Nikon asserts that there
2 “could have been an error in assignment.” But this does not count as sufficient
3 disclosure, nor is it any basis for disputing the fact that Plaintiffs do, in fact, own the
4 patents-in-suit.

5 Therefore, Plaintiffs ask that this Court grant the motion, and require disclosure
6 of claims Nikon intends to pursue at trial and the basis for those claims, as required
7 by the local rules. Given that trial is next week, Plaintiffs’ have waived oral argument
8 (D.I. 443) and respectfully request that the Court consider and decide this motion at
9 its earliest convenience.

1 Dated: July 3, 2018

FISH & RICHARDSON P.C.

2 By: /s/ Oliver J. Richards

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the above and foregoing document has been served on July 3, 2018, to all counsel of record who are deemed to have consented to electronic service via the Court's CM/ECF system per Civil Local Rule 5.4. Any other counsel of record will be served by electronic mail, facsimile and/or overnight delivery.

/s/ Oliver J. Richards

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